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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,507	05/08/2006	Ritsuko Ehama	053466-0446	7877

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EXAMINER	
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ART UNIT	PAPER NUMBER
1623	

MAIL DATE	DELIVERY MODE
11/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

For purposes of appeal, Applicant's proposed amendment AFTER FINAL, filed 17 Oct 2008, in which withdrawn claims 5-10, 13 and 14 are canceled, will be entered.

Continuation of 11.

Applicant's Remarks, filed 17 Oct 2008, have been fully considered and found not to be persuasive.

With regard the rejection of amended claims 1-4, 11 and 12 under 35 U.S.C. 102(b) as being anticipated by Tajima (US Patent Application Publication US 2002/0192177, published 19 Dec 2002, of record) in the Office Action mailed 17 July 2008, Applicant remarks that the instantly claimed method facilitates recovery of the hair to its thickness in its previous anagen phase after repetitions of hair cycles. These limitations are not found in the claims. Therefore the instantly claimed method encompasses maintaining and promoting hair thickening during the anagen phase of the hair cycle.

Applicant asserts that Tajima does not disclose a method for maintaining and promoting the thickness of hair. However, Tajima at page 1, paragraph 16 discloses "hair care" is used in the sense including a hair loss preventing action and a hair growth promoting action. A hair loss preventing action would necessarily maintain the thickness of a hair by preventing the hair from being lost. A hair growth promoting action promotes the thickness of hair according to the diagram of hair (Britannica Online Encyclopedia, of record) because the growth of the hair increases the diameter of the

hair as indicated by the conical shape of the hair, which has a larger diameter at the base at which it is growing. Because of the shape of the hair, it is apparent that an agent that promotes hair growth necessarily promotes an increase in the diameter of the hair, or "hair thickening".

Applicant remarks that the claims are not directed to a new function or a mechanism of action for FGF-7. With regard the rejection of amended claims 1-4, 11 and 12 under 35 U.S.C. 102(b) as being anticipated by Tajima in the Office Action mailed 17 July 2008, instant claim 1 recites a method directed to a new function or a mechanism of action for applying the hair tonic disclosed by Tajima to the scalp of a human subject, said hair tonic comprising adenosine or adenosine 5'-phosphate as an active ingredient. As recited above, the application of said hair tonic, a method comprising the same active steps, anticipates the instantly claimed method for maintaining and promoting the thickness of hair within the scope of the method claimed. The mechanism of action of "increasing the expression of keratinoctye growth factor (FGF-7) in hair follicle cells" of a known treatment comprising the same active steps, i.e., administering the same compound in the same amount to the same or similar patient population, is a latent property of the method in the prior art. Mere recognition of latent properties in the prior art does not render novel or nonobvious an otherwise known invention. See *In re Wiseman*, 201 USPQ 658 (CCPA 1979).

With regard to *Jansen v. Rexall Sunudown* 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003), Tajima at page 1, paragraph 16 discloses the intended use of "hair care" used in the sense including a hair loss preventing action and a hair growth

promoting action, meeting the limitation of the instantly claimed invention of applying said preparation to the scalp of a subject in need thereof. Tajima discloses the same intent, or intended use, as the instantly claimed method for maintaining and promoting the thickness of hair of a subject in need thereof. The inherency of the mechanism of action is not addressed in *Jansen v. Rexall Sunudown*.

The response above regarding Tajima are also applied with regards to the rejection of amended claims 1-4, 11 and 12 on the ground of nonstatutory double patenting over claim 1 of U.S. Patent 7,182,939.

With regards to rejection of amended claims 1-4, 11 and 12 on the ground of provisional nonstatutory double patenting over claim 4 of copending Application No. 11/655,134, as this is not the only remaining grounds rejection, it is proper to maintain this provisional rejection.

/Shaojia Anna Jiang/

Supervisory Patent Examiner, Art Unit 1623

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/578,507	**Applicant(s)** EHAMA ET AL.	
	Examiner Jonathan S. Lau	**Art Unit** 1623	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *none*.
   Claim(s) objected to: *none*.
   Claim(s) rejected: *1-4,11 and 12*.
   Claim(s) withdrawn from consideration: *none*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Shaojia Anna Jiang/
Supervisory Patent Examiner, Art Unit 1623